

I. REMARKS

In the July 14, 2006 Office Action, the Examiner:

- Rejected claims 45-66 under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 6,256,613 to Falchuk *et al.* (Falchuk) in view of U.S. Pat. No. 5,737,539 to Edelson *et al.* (Edelson).

The specification has been amended to correct a typographical error. Claims 67 through 88 have been withdrawn from consideration as drawn to non-elected species. New claims 89-90 include additional limitations not disclosed by Falchuk or Edelson. Claim 45 has been amended to further distinguish the claims over the prior art of Falchuk and Edelson. Support for these amendments and new claims can be found, for example, on page 15, lines 1-4 and in Figures 4A, 4B, 4C, and 4D. No new matter has been added.

A. Interview Summary

On Tuesday, October 24, 2006 the undersigned and D. Bregman (Reg. No. 45,645) participated in a telephonic interview with Examiner D. Cobanoglu, and Primary Examiner R. Morgan. Applicant's Representative provided a general description of the application history and Assignee Epocrates's technology as it relates to the claimed invention. The Examiners were invited to visit <http://www.epocrates.com/products/docalert/>. Over 25% of physicians in the United States use Epocrates's technology on a daily basis. *See* <http://www.epocrates.com/company/>.

Independent claim 45 was discussed in detail. In particular, Applicant's Representatives explained why they did not believe the cited prior art disclosed the claim limitations reciting "identifying a physician from a database of multiple physicians" and "generating an interactive message comprising medical information customized to said identified physician." Applicant's Representatives noted that the current application describes interactive messages as including questions and possible responses or answers that the physician can select to dispose of the message. *See* page 21, last full paragraph and Figure 4. The Examiners suggested amending the claim language to further clarify the extent of the interactive message, and that the physician is identified and the interactive message is generated by a computer and transmitted to a handheld device in response to a

communication signal from the handheld device, such as a synchronization signal. The Applicant agreed to make these changes as per the amendments submitted herewith.

In the unlikely event that the Examiner still believes that the amended claims are insufficient to distinguish the claims over the prior art, Applicant requested that the Examiner call the undersigned attorney to discuss the possibility of an amendment to place the application in condition for allowance.

Applicant also submitted that claims 51, 56, 57, and 58 were allowable for additional reasons.

No agreement on the allowability of the claims was reached; however, the Examiners agreed to call the undersigned to set up another interview before issuing another Office Action rejecting the claims.

B. Claims 45-66 are patentable over Falchuk in view of Edelson.

1. The Law on Obviousness

To establish a prima facie case of obviousness, three basic criteria must be met, namely:

- 1) The prior art reference (or references when combined) must teach or suggest all the claim limitations.
- 2) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; and
- 2) There must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP § 706.02(j).

The motivation to modify or combine the prior art references must be found in the teachings of the prior art, the knowledge of persons of ordinary skill in the art, or the nature of the problem to be solved. *See In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

2. Falchuk fails to disclose many of the claimed limitations of independent claim 45

Falchuk discloses a medical consultation management system in which a primary care physician requests a consultation with a specialist physician via a supervisory host computer. At the supervisory host computer, a staff physician designates a specialist, adds supporting documentation, and, thereafter transmits the request to a specialist. The specialist then responds to the primary care physician's request via the supervisory host computer. *See* Abstract.

As the Examiner correctly notes, Falchuk does not disclose the use of **handheld devices**. In particular, Falchuk does not disclose "receiving a communication signal from a handheld computing device operated by said identified physician; and in response to said communication signal, transmitting said interactive message from the computer system to said handheld computing device," as required by independent claim 45, as amended.

Furthermore, Falchuk does not disclose "identifying a physician **from a database of multiple physicians**." (Emphasis added.) The Examiner states that Falchuk discloses "[i]dentifying a physician from a database of multiple physicians (Falchuk; col. 6, lines 11-17)." Note that, as is clear from the structure of the pending claims, the physician identified in the claims is the recipient of the interactive message, not the author. Falchuk, however, does not disclose a database of multiple recipient physicians at all, much less the step of identifying such a recipient physician from such a database. The cited portion of Falchuk merely discloses that the primary care physician (author) identifies herself, not the recipient of an interactive message, as required by the claims. This self-identifying step has no relationship to selection of a recipient physician from a database of multiple physicians.

In addition, Falchuk does not disclose "generating an **interactive message** comprising medical information customized to said identified physician." New claim language has been added to clarify that the interactive message further comprises "objects that the physician can select to respond to, or dispose of, the interactive message." The Examiner cites Falchuk column 6, lines 11-17 for this claim limitation; however, this portion of Falchuk discloses sending the primary care physician pending responses from the supervisory host computer. No teaching is made that the pending responses are interactive or comprise objects that the physician can select to respond to, or dispose of, the interactive message.

Independent claim 45, as amended, also recites “receiving a communication signal from a handheld computing device operated by said identified physician; and **in response to said communication signal**, transmitting said interactive message from the computer system to said handheld computing device.” The Examiner admits that Falchuk does not disclose any of these limitations, stating “Falchuk fails to expressly teach the receiving a communication signal from and transmitting said interactive message to a handheld computing device, per se, since it appears that Falchuk is more directed to a personal computer (Falchuk; col. 2, lines 11-21).”

Thus, Falchuk does not disclose at least the limitations of the pending claims described above.

3. Edelson also fails to disclose the same limitations of claim 45 missing from Falchuk

Edelson discloses a prescription creation system that accesses remote databases, dynamically creates a transient virtual patient record, and provides the prescriber with drug, drug formulary, and patient history information at a point of care. *See* Abstract. Edelson further discloses implementing this system on a personal digital assistant. *See* column 7, lines 44-49.

Edelson is not cited for nor does it teach: (i) “identifying a physician from a database of multiple physicians,” or (ii) “generating an interactive message comprising medical information customized to said identified physician and objects the physician can select to respond to or dispose of the interactive message” as claimed. Nor does Edelson disclose that the transmission of the interactive message is done “**in response to said communication signal**,” as recited in the amended claims.

The Examiner cites column 7, lines 44-49 and column 44, lines 16-23 and 33-36 referencing Figure 16 of Edelson for teaching handheld computing devices and in particular the limitation of independent claim 45 requiring that the method include “receiving a communication signal from” and “transmitting said interactive message from the computer system to a handheld computing device.” Despite a careful review of Edelson, Applicant could not locate any reference to transmitting an interactive message.

While, Figure 16 shows a schematic of a system for connecting users to the prescription management system, neither the figure nor the accompanying text address what is transmitted or received by the system. The description of Figure 16 in column 44 describes a flow of “data and communications resources” but does not describe transmitting interactive messages in response to a communication signal from the handheld device. Similarly the cited portion of column 7 does not describe transmitting interactive messages to a handheld device in response to a communication signal from the handheld device. Thus, it is respectfully submitted that Edelson fails to disclose the entire limitation for which it is cited and the interactive message that is missing from Falchuk.

Thus, Edelson also does not disclose any of the many claim limitations missing from Falchuk.

4. *No possible combination of Falchuk and Edelson renders claim 45 obvious*

As noted above, the references, either alone or in combination do not teach or suggest many of the limitations of claim 45 or any claim dependent thereon. For example, neither reference discloses: (i) “identifying a physician from a database of multiple physicians,” (ii) “generating an interactive message comprising medical information customized to said identified physician and objects the physician can select to respond to or dispose of the interactive message,” (iii) “receiving a communication signal from a handheld computing device operated by said identified physician”, or (iv) “in response to said communication signal, transmitting said interactive message from the computer system to a handheld computing device.”

In addition, there is no motivation to combine Falchuk and Edelson to arrive at the claimed invention. Instead, Edelson teaches away from a combination with Falchuk and would lead one skilled in the art to believe there was no reasonable expectation of success if one tried to make such a combination, since any such combination is “fraught with unexpected difficulties.” Edelson, column 2, lines 51-53. A reasonable expectation of success and at least some degree of predictability are required for a showing of obviousness. See MPEP § 2143.02. Edelson is evidence showing there was no reasonable expectation of success, which supports a conclusion that the claims are nonobvious. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

Falchuk is directed toward solving the problem of the need for managed, direct access to outside medical consultants, while Edelson seeks to solve the problem of providing a computerized, prescription management system. See Falchuk, column 1, lines 40-41 and Edelson, column 4, lines 17-18. Therefore, one skilled in the art of managing consultations between primary care physicians and specialists would not look to Edelson for a solution.

The Office Action asserts that one would be motivated to use handheld devices to avoid the cost of hard wiring and provide users with a small device in practicing the invention of Falchuk, citing Edelson, column 3, lines 32-44. But, the system of Falchuk requires significant physician input, including specifying the request, self-identification, and “entry of data describing the patient ... the patient’s clinical history ... [and] the particular question” for the specialist. Falchuk, column lines 31-33. This amount of data entry on a handheld device is not convenient for physicians and neither Falchuk nor Edelson teach that Falchuk’s consultation request should be done at the point of care. Thus, the proposed modification of Falchuk by Edelson is not motivated by the prior art and renders Falchuk unsatisfactory for its intended purpose. See, MPEP § 2143.01(V). Instead of providing a motivation to combine its teachings with Falchuk’s, Edelson teaches that such a combination would be unlikely to succeed.

Thus, it is improper to combine Edelson with Falchuk since neither reference provides motivation to combine the references, there no evidence that one skilled in the art would combine the references, the references solve different problems, and there is no reasonable expectation that such a combination would be successful. Thus, Falchuk and Edelson cannot be combined to render the pending claims obvious.

5. Both Falchuk and Edelson fail to disclose additional limitations of the dependent claims

a. Falchuk and Edelson fail to disclose the additional limitations of Claim 51

Dependent claim 51 recites, *inter alia*, that “the interactive message includes an inquiry whether said physician wishes to receive CME at the handheld computing device.” Falchuk does not disclose an inquiry whether said physician wishes to receive CME. The

Examiner states that “Falchuk discloses the method of claims 45, wherein the interactive message includes an inquiry whether said physician wishes to receive Continuing Medical Education (CME) (Falchuk; column 5, lines 48-58);” however, this portion of Falchuk teaches that the consultation may be accredited in order to certify that the primary care physician may receive CME credit. There is no inquiry of the physician’s wishes. Falchuk does not teach asking whether the primary care physician wishes to receive CME. Instead it appears that the Falchuk’s consultations are automatically Continuing Medical Education.

Furthermore, Edelson does not disclose anything about CME and certainly does not disclose that an interactive message includes an inquiry whether the physician wishes to receive CME, as required by claim 51. Thus, Edelson fails to disclose the limitation requiring an interactive message having an inquiry whether the physician wishes to receive CME that is missing from Falchuk.

b. Falchuk and Edelson fail to disclose the additional limitations of Claims 56 and 57

Dependent claim 56 recites, *inter alia*, that “generating further comprises associating an expiration date with said interactive message, such that said message expires after a predetermined time.” Dependent claim 57 recites that the expired interactive message is “removed from said handheld computing device.” Falchuk does not disclose an expiration date associated with the interactive message. The Examiner cites Falchuk column 4, lines 53-61 for teaching these limitations; however, this portion of Falchuk teaches that the staff physician receives delay notification if the specialist does not respond in a timely fashion, “within a predetermined duration” and may select a different specialist. This is not the same as associating an expiration date with an interactive message, such that the message expires after a predetermined time, or removing the interactive message from the handheld device according to the expiration data as claimed. Falchuk does not teach an expiration date associated with an interactive message, that an interactive message expires, is removed from the handheld computing device.

While Edelson teaches that the prescription creation system may include information about when a prescription will run out or expire, it fails to disclose the limitations of claims 56 and 57. See, e.g., column 22, lines 60-63. The only expiration date discussed in Edelson is the expiration date of a prescription, rather than an expiration date associated with an

interactive message, as claimed. Thus, Edelson also fails to disclose the limitations regarding an expiration date associated with the interactive message that are missing from Falchuk.

c. Falchuk and Edelson fail to disclose the additional limitations of Claims 58

Dependent claim 58 recites that the “interactive message is configured to be **automatically displayed** once downloaded.” As noted above, Falchuk does not disclose an interactive message. Nor does Falchuk disclose configuring an interactive message to be automatically displayed. The Examiner previously, incorrectly appeared to equate Falchuk’s “pending responses from the supervisory host computer” with the claimed interactive message. No teaching to configure these responses to be automatically displayed to the primary care physician is noted. Instead the Examiner cites column 6, lines 24-43, which teach that the primary care physician can enter her request by completing a sequence of display forms. These display forms are not interactive messages comprising customized medical information but are generic input forms for the primary care physician to use in making a request. Furthermore, these display forms are not configured to be automatically displayed once downloaded, but must be requested by the primary care physician, as stated for example, in column 6, lines 25, or 28-29.

As noted above, Edelson does not disclose an interactive message. Nor does Edelson disclose configuring an interactive message to be automatically displayed. Thus, Edelson fails to disclose the limitation requiring that the interactive message is configured to be automatically displayed once downloaded that is missing from Falchuk, as required by claim 58.

Thus, Edelson does not disclose all of the claim limitations alone, or in combination with Falchuk.

II. CONCLUSION

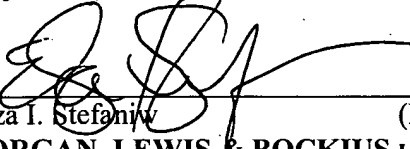
For at least these reasons, claims 45-66 and 89-90 cannot be unpatentable over Fachuk in view of Edelson, as the prior art references, either alone or in combination, do not teach or suggest all of the claim limitations; and the proposed modification of Falchuk by Edelson is improper because there is no reasonable expectation of success and Edelson teaches away from such a combination.

In view of the foregoing amendments and remarks made in response to the Examiners' comments and suggestions during the interview, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant requests that the Examiner call the undersigned attorney at 650-843-7519 to set up an interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 061018-0007-US-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

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